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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,293	09/16/2005	Munetake Ebihara	277771US6PCT	5131
22850	7590	04/20/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			SU, EMILE	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			3685	
			NOTIFICATION DATE	DELIVERY MODE
			04/20/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/549,293	Applicant(s) EBIHARA ET AL.
	Examiner EMILE SU	Art Unit 3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 22 January 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/DP/0656)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgments

1. This Office Action is in response to communications filed on January 22, 2009.
2. Claims 1, 5, and 8 are amended. Claim 4 is cancelled.
3. Claims 1-3 and 5-10 are currently pending and have been rejected.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 8-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Concerning Claim 8, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a "process" under 35 U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 8 fails prong (1) because there is insufficient tie to a machine or structure for **all the limitations in the body of the claim**. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

As to Claims 9 and 10, see discussion of Claim 8 above. These depending claims repeat the same U.S.C. §101 deficiency of Claim 8 above.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-3 and 5-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, Applicant recites “computer-readable storage medium” in attempt to claim a system. However, much of the claim is directed to functions of a file and what the file does. The limitations in the body of the claim is inconsistent with what Applicant has set forth to claim in the preamble. This renders the scope of the claim to be unclear to one of ordinary skill in the art.

Further regarding Claim 1, the claim limitation “authenticating means for ... key obtaining means for ... transmitting means for” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because authenticating is modified by second execution file; key obtaining is modified by first execution file; transmitting is modified by second execution file.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (*e.g.*, deleting the phrase “means for” or “step for”).

Also regarding Claim 1, Applicant recites “when said computer-readable storage medium is inserted into said information processing apparatus and said second execution

file generates a content key form said unique key information, decrypts" in the eleventh line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether generating a content key is another condition following the first condition of inserting a medium or there is only one condition of inserting a medium. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also regarding Claim 1, Applicant recites "encrypted content" in the thirteenth line of the claim. The previous act of encrypting a content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Clam 1, Applicant recites "the decrypted content" in the fourteenth line of the claim. The previous recitation of a decrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 1, Applicant recites "said content" in the fifteenth and seventeenth line of the claim. The previous recitation of a content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 1, Applicant recites "said unique key information is used to encrypt encryption key information for encryption digital signature information" in the sixteenth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether the encrypted key information or just the key information is used to encrypt a signature. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also regarding Claim 1, Applicant recites "digital signature information attached to said content" in the sixteenth line of the claim .The previous act of attaching a

signature can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 1, Applicant recites “transmitting means transmits said content to said second execution file” in the seventeenth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out how a file that has no inputting means is able take part in the transmission of a content. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Regarding Claim 2, Applicant recites “said unique key information is used to encrypt encryption key information for encrypting digital signature information” in the sixteenth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether the encrypted key information or just the key information is used to encrypt a signature. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Regarding Claim 3, Applicant recites “said content” in the second line of the claim. The previous recitation of a content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 5, Applicant’s recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims an “information processing apparatus” while also claiming a process of using the system “said transmitting means transmits said content”. A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to

particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

Further regarding Claim 5, Applicant recites “An information apparatus” in attempt to claim a system. However, much of the claim is directed to functions of a file and what the file does. The limitations in the body of the claim is inconsistent with what Applicant has set forth to claim in the preamble. This renders the scope of the claim to be unclear to one of ordinary skill in the art.

Also regarding Claim 5, the claim limitation “authenticating means for … key generating means for … decrypting means for … reproducing means for” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because authenticating is modified by second execution file; key generating is modified by unique key information; decrypting means is modified by encryption key information; reproducing means is modified by decrypted content.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be

a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

Also regarding Claim 5, Applicant recites “unique key information obtained from said first execution file” in the ninth line of the claim. The previous act of obtaining unique key information can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 5, Applicant recites “said encrypted content” in the tenth line of the claim. The previous recitation of an encrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 5, Applicant recites “the decrypted content” in the eleventh line of the claim. The previous recitation of a decrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 5, Applicant recites “said content” in the fourteen and sixteen line of the claim. It is unclear if the phrase refers to “said encrypted content”, “the decrypted content”, or a different content. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 5, Applicant recites “said unique key information is used to encrypt encryption key information for encrypting digital signature information” in the sixteenth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether the encrypted key information or just the key information is used to encrypt a signature. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also regarding Claim 5, Applicant recites “digital signature information attached to said content” in the sixteenth line of the claim. The previous act of attaching a signature can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 5, Applicant recites “said transmitting means” in the sixteenth line of the claim. The previous recitation of a transmitting means can not be found. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 6, Applicant recites “said encrypted content” in the second line of the claim. The previous recitation of an encrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Further regarding Claim 6, Applicant recites “one of said computer-readable storage medium, in said information processing apparatus, and in a different information processing apparatus” in the second line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether “in said information processing apparatus” is a destination for recording the encrypted content or is it merely describing where “said computer-readable storage medium” is located. *See In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989).*

Regarding Claim 7, Applicant recites “said encrypted content” in the second and fourth line of the claim. The previous recitation of an encrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Further regarding Claim 7, Applicant recites “said unique key information is used to encrypt encryption key information for encrypting digital signature information”

in the fourth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether the encrypted key information or just the key information is used to encrypt a signature. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also regarding Claim 7, Applicant recites “digital signature information attached to said content” in the fourth line of the claim. The previous act of attaching a signature can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 7, the claim limitation “receiving means for” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because receiving is modified by digital signature information.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (*e.g.*, deleting the phrase “means for” or “step for”).

Regarding Claim 8, Applicant recites “unique key information obtained from said first execution file” in the sixth line of the claim. The previous act of obtaining unique key information can not be found. There is insufficient antecedent basis for this limitation in the claim.

Further regarding Claim 8, Applicant recites “said content” in the ninth line of the claim. It is unclear whether the phrase refers to “an encrypted content” or a different content. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 8, Applicant recites “the decrypted content” in the tenth line of the claim. The previous recitation of a decrypted content can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 8, Applicant recites “using unique key information to encrypt encryption key information for encrypting digital signature information” in the eleventh line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether the encrypted key information or just the key information is used to encrypt a signature. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also regarding Claim 8, Applicant recites “digital signature information attached to said content” in the twelfth line of the claim. The previous act of attaching a signature can not be found. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 8, Applicant recites “said content” in the thirteenth line of the claim. It is unclear if the phrase refers to “said encrypted content”, “the decrypted

content”, or a different content. There is insufficient antecedent basis for this limitation in the claim.

Also regarding Claim 8, Applicant recites “transmitting said content o said second execution file” in the thirteenth line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out how a file that has no inputting means is able take part in the transmission of a content. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Regarding Claim 9 and 10, Applicant recites “said content” in the second line of each claim. It is unclear if the phrase refers to “said encrypted content”, “the decrypted content”, or a different content. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 1-3, 5, 6, and 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 6,253,193 B1 (hereinafter Ginter) in view of Hughes, U.S. Patent No. 6,748,537 B2 (hereinafter Hughes), and further in view of Matsuyama et al., U.S. Patent Applicant Publication No. 2002/0026581 A1 (hereinafter Matsuyama).

With respect to Claim 1, Ginter discloses a computer-readable storage medium comprising:

a first (i.e. PPE A, see Ginter, Column 218, Lines 33-38) execution file (i.e. contain executable code, see Ginter, Column 86, Lines 36-48) recorded on said computer-readable storage medium (i.e. stored in CD-ROM, see Ginter, Column 62, Line 43 to Column 63, Line 17) using a copy protection mechanism (i.e. rights protection mechanism, see Ginter, Column 2, Line 61 through Column 3, Line 9), said first execution file including

authenticating means for performing an authentication process with a second (i.e. PPE B, see Ginter, Column 218, Lines 33-38) execution file (i.e. establishes and authenticates, see Ginter, Column 12, Lines 33-39),
key obtaining means for obtaining unique key information unique to said first execution file (i.e. unique session key, see Ginter, Column 219, Line 52 through Column 220, Line 19), and
transmitting means for transmitting said unique key information to said second execution file (i.e. Deliver protected session key, see Ginter, Column 219, Line 52 through Column 220, Line 19),
an information processing apparatus including a processor (i.e. contains a processor to perform instructions, see Ginter, Column 59, Line 60 through Column 60, Line 8), said second execution file generates (i.e. decrypt secure information, see Ginter, Column 71, Lines 32-41; also see Column 200-201 for secure communication using keys) a content key (i.e. content ... that may be encrypted using one or more content key, see Ginter, Column 130, Lines 25-40) from said unique key information (i.e. decryption keys, see Ginter, Column 66, Lines 12-18; note that unique key information is a session key now being used for decrypting), decrypts encrypted content using the content key (i.e. decrypt the object's content, see Ginter, Column 206, Line 61 through Column 207, Line 7), and reproduces the decrypted content (i.e. playing said music, see Ginter, Column 320, Line 62 through Column 321, Line 18), and
wherein said content is recorded on said computer-readable medium (i.e. encrypting information before storing it, see Ginter, Column 62, Line 42 through Column

63, Line 17) and said unique key information is used to encrypted encryption key information for encrypting a content (i.e. A “master” key is key used to encrypt other keys, see Ginter, Column 212, Lines 12-38).

However, Ginter does not specifically disclose wherein a file is executed when inserted into an information processing apparatus. Hughes does teach wherein a file is executed when inserted into an information processing apparatus (i.e. player software on the CD is automatically executed, see Hughes, Column 3, Line 32 through Column 4, Line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to automate execution of a file upon insertion, because this expands a product’s targeted market to users unfamiliar with electronic equipment and gives the content owner control over how content should be managed.

Ginter does not specifically disclose encrypting digital signature information attached to said content; and said transmitting means transmits said content to said second execution file based on said digital signature information. Matsuyama does teach encrypting digital signature information attached to said content (i.e. attach his/her signature encrypted with the private key to a document, see Matsuyama, ¶169); and said transmitting means transmits said content to said second execution file based on said digital signature information (i.e. transmitted by means of encryption using the public key certificate, see Matsuyama, ¶165; also see ¶160-169). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt digital signature information and transmit data as taught by Matsuyama, because digital signature can verify the authenticity of the sender (see Matsuyama, ¶166).

Further, the claim limitation “a first execution file recorded on said computer-readable storage medium using a copy protection mechanism, said first execution file including ... transmitting means for transmitting said unique key information to said second execution file” is directed to a mere data structure stored on a computer readable medium. **The claim still lacks necessary language that realizes the computer program’s functionality.** Specifically, Claim 1 is lacking an interrelationship between the computer program and a device for performing a function. As mere example, an acceptable form to claim data structures would be “computer-readable code stored on a computer-readable medium, when the computer-readable code is executed, causing a computer processor to perform a calculation of data”. The claimed limitation is representative of nonfunctional descriptive material as the instructions are not functionally related to the structure of the claimed invention. See MEPE §2106.01; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). This limitation is not given patentable weight for the purpose of prior art examination.

Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The limitation “wherincin said first execution file is executed by an information processing apparatus ... and said transmitting means transmits said content to said second execution file based on said digital signature information” is not given patentable weight for the purpose of prior art examination.

Further, the limitation “said unique key information is used to encrypt encryption key information for encrypting digital signature information attached to said content” merely present the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967)). This limitation is not given patentable weight for the purpose of prior art examination.

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C).

As to Claim 2, see discussion of Claim 1 above. Ginter further discloses wherein said unique key information is used to encrypt encryption key information for encrypting a content (i.e. A “master” key is key used to encrypt other keys, see Ginter, Column 212, Lines 12-38).

Further, the limitation “said unique key information is used to encrypt encryption key information for encrypting a content” merely present the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967)). This limitation is not given patentable weight for the purpose of prior art examination.

As to Claim 3, see discussion of Claim 2 above. Ginter further discloses wherein at least one of said second execution file (i.e. code that is executed, see Ginter, Column 62, Line 58 through Column 63, Line 17) and said content is recorded on said computer-readable storage medium (i.e. encrypting information before storing it, see Ginter, Column 62, Line 42 through Column 63, Line 17).

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C)).

With respect to Claim 5, Ginter discloses an information processing apparatus (i.e. circuit, see Ginter, Column 59, Line 60 through Column 60, Line 8) into which a computer-readable storage medium is inserted (i.e. stored in CD-ROM, see Ginter, Column 62, Line 43 to Column 63, Line 17), said computer-readable storage medium including a first (i.e. PPE A, see Ginter, Column 218, Lines 33-38) execution file (i.e. contain executable code, see Ginter, Column 86, Lines 36-48) recorded using a copy protection mechanism (i.e. rights protection mechanism, see Ginter, Column 2, Line 61 through Column 3, Line 9), said information processing apparatus comprising:

a processor (i.e. contains a processor to perform instructions, see Ginter, Column 59, Line 60 through Column 60, Line 8); and

a second (i.e. PPE B, see Ginter, Column 218, Lines 33-38) execution file for reproducing (i.e. playing said music, see Ginter, Column 320, Line 62 through Column

321, Line 18) and encrypted content (i.e. decrypt the object's content, see Ginter, Column 206, Line 61 through Column 207, Line 7; note that the content is encrypted for decryption),

wherein said second execution file includes authenticating means for performing an authentication process with said first execution file (i.e. three-way X.509 public key protocol steps, see Ginter, Column 218, Line 60 through Column 220, Line 19), key generating means for generating (i.e. decrypt secure information, see Ginter, Column 71, Lines 32-41; also see Column 200-201 for secure communication using keys) encryption key information (i.e. content ... that may be encrypted using one or more content key, see Ginter, Column 130, Lines 25-40) based on unique key information obtained from said first execution file (i.e. decryption keys, see Ginter, Column 66, Lines 12-18; note that unique key information is a session key now being used for decrypting), decrypting means for decrypting said encrypted content using said encryption key information (i.e. decrypt the object's content, see Ginter, Column 206, Line 61 through Column 207, Line 7), and reproducing means for reproducing the decrypted content (i.e. playing said music, see Ginter, Column 320, Line 62 through Column 321, Line 18), and

wherein said content is recorded on said computer-readable medium (i.e. encrypting information before storing it, see Ginter, Column 62, Line 42 through Column 63, Line 17) and said unique key information is used to encrypted encryption key information for encrypting a content (i.e. A "master" key is key used to encrypt other keys, see Ginter, Column 212, Lines 12-38).

However, Ginter does not specifically disclose wherein file is executed when said computer-readable storage medium is inserted into the information processing apparatus.

Hughes does teach wherein file is executed when said computer-readable storage medium is inserted into the information processing apparatus (i.e. player software on the CD is automatically executed, see Hughes, Column 3, Line 32 through Column 4, Line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to automate execution of a file upon insertion, because it is convenient for users unfamiliar with electronic equipment and gives the content owner control over how content should be managed.

However, Ginter does not specifically disclose encrypting digital signature information attached to said content; and said transmitting means transmits said content to said second execution file based on said digital signature information.

Matsuyama does teach encrypting digital signature information attached to said content (i.e. attach his/her signature encrypted with the private key to a document, see Matsuyama, ¶169); and said transmitting means transmits said content to said second execution file based on said digital signature information (i.e. transmitted by means of encryption using the public key certificate, see Matsuyama, ¶165; also see ¶160-169).

It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt digital signature information and transmit data as taught by Matsuyama, because digital signature can verify the authenticity of the sender (see Matsuyama, ¶166).

Further, the claim limitation “wherein said second execution file includes authenticating means ... and wherein said second execution file is executed when said computer-readable storage medium is inserted into the information processing apparatus” is directed to a mere data structure stored on a computer readable medium. **The claim still lacks necessary language that realizes the computer program's functionality.** Specifically, Claim 5 is lacking an interrelationship between the computer program and a device for performing a function. As mere example, an acceptable form to claim data structures would be “computer-readable code stored on a computer-readable medium, when the computer-readable code is executed, causing a computer processor to perform a calculation of data”. The claimed limitation is representative of nonfunctional descriptive material as the instructions are not functionally related to the structure of the claimed invention. See MEPE §2106.01; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). This limitation is not given patentable weight for the purpose of prior art examination.

Further, the limitation “said unique key information is used to encrypt encryption key information for encrypting digital signature information attached to said content” merely present the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967)). This limitation is not given patentable weight for the purpose of prior art examination.

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010

(Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C).

As to Claim 6, see discussion of Claim 5 above. Ginter further discloses wherein said encrypted content is recorded on one of said computer-readable storage medium (i.e. encrypting information before storing it, see Ginter, Column 62, Line 42 through Column 63, Line 17; note secondary storage is computer-readable storage medium), in said information processing apparatus, and in a different information processing apparatus (i.e. semiconductor memory, see Ginter, Column 21, Lines 5-42).

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C)).

As to Claim 7, Ginter discloses the invention substantially as claimed. Ginter further discloses said unique key information is used to encrypt encryption key information (i.e. Master Key, see Ginter, Column 212, Lines 12-38; note master key is a concept of communicating other keys in a secure way). However, Ginter does not specifically disclose encrypting digital signature information attached to said encrypted content, and receiving means for receiving said encrypted content based on said digital signature.

Matsuyama does teach encrypting digital signature information attached to said encrypted content (i.e. attach his/her signature encrypted with the private key to a

document, see Matsuyama, ¶169), and receiving means for receiving said encrypted content (i.e. Upon reception of the document, see ¶169) based on said digital signature (i.e. transmitted by means of encryption using the public key certificate, see Matsuyama, ¶165; also see ¶160-169).

It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypted digital signature information and transmit data as taught by Matsuyama, because digital signature can verify the authenticity of the sender (see Matsuyama, ¶166).

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C)).

With respect to Claim 8, Ginter teaches an information processing method of an information processing apparatus (i.e. contains a processor to perform instructions, see Ginter, Column 59, Line 60 through Column 60, Line 8), a computer-readable storage medium (i.e. stored in CD-ROM, see Ginter, Column 62, Line 43 to Column 63, Line 17) having a first (i.e. PPE A, see Ginter, Column 218, Lines 33-38) execution file (i.e. contain executable code, see Ginter, Column 86, Lines 36-48) recorded therein using a copy protection mechanism (i.e. rights protection mechanism, see Ginter, Column 2, Line 61 through Column 3, Line 9), said information processing method comprising:

performing by a processor (i.e. contains a processor to perform instructions, see Ginter, Column 59, Line 60 through Column 60, Line 8), authentication process with said first execution file (i.e. three-way X.509 public key protocol steps, see Ginter, Column 218, Line 60 through Column 220, Line 19); generating (i.e. decrypt secure information, see Ginter, Column 71, Lines 32-41; also see Column 200-201 for secure communication using keys) encryption key information (i.e. content ... that may be encrypted using one or more content key, see Ginter, Column 130, Lines 25-40) based on unique key information obtained from said first execution file (i.e. decryption keys, see Ginter, Column 66, Lines 12-18; note that unique key information is a session key now being used for decrypting);

decrypting an encrypted content using said encryption key information (i.e. decrypt the object's content, see Ginter, Column 206, Line 61 through Column 207, Line 7);

recording said content on said computer-readable storage medium (i.e. encrypting information before storing it, see Ginter, Column 62, Line 42 through Column 63, Line 17);

reproducing the decrypted content (i.e. playing said music, see Ginter, Column 320, Line 62 through Column 321, Line 18);

using unique key information to encrypted encryption key information for encrypting a content (i.e. A "master" key is key used to encrypt other keys, see Ginter, Column 212, Lines 12-38).

However, Ginter does not specifically teach into which a computer-readable storage medium is inserted.

Hughes does disclose into which a computer-readable storage medium is inserted (i.e. when the storage medium is inserted, see Hughes, Column 3, Line 32 through Column 4, Line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to create an computer-readable storage medium that can be inserted, because it is a removable medium is convenient to transport across different equipment (see Hughes, Column 2, Lines 7-50).

However, Ginter does not specifically disclose encrypting digital signature information attached to said content; and said transmitting means transmits said content to said second execution file based on said digital signature information.

Matsuyama does teach encrypting digital signature information attached to said content (i.e. attach his/her signature encrypted with the private key to a document, see Matsuyama, ¶169); and said transmitting means transmits said content to said second execution file based on said digital signature information (i.e. transmitted by means of encryption using the public key certificate, see Matsuyama, ¶165; also see ¶160-169).

It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt digital signature information and transmit data as taught by Matsuyama, because digital signature can verify the authenticity of the sender (see Matsuyama, ¶166).

Further, the limitation “using unique key information to encrypt encryption key information for encrypting digital signature information attached to said content” merely presents the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967)). This limitation is not given patentable weight for the purpose of prior art examination.

Further, it has been held that a whereby/wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C).

As to Claim 9, see discussion of Claim 2 above. Ginter further discloses wherein at least one of said second execution file (i.e. execute VDE related instructions, see Ginter, Column 21, Lines 5-42) and said content is recorded in said information processing apparatus (i.e. semiconductor memory, see Ginter, Column 21, Lines 5-42).

As to Claim 10, see discussion of Claim 2 above. Ginter discloses the invention substantially as claimed. However, Ginter does not specifically disclose wherein at least one of said second execution file and said content is recorded in a different information processing apparatus.

Hughes does teach wherein at least one of said second execution file and said content is recorded in a different information processing apparatus (i.e. transferred to another computer, see Hughes, Column 2, Lines 22-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to store content in a second (i.e. PPE B, see Ginter, Column 218, Lines 33-38) apparatus, because this reduces the memory load necessary for the first apparatus.

Conclusion

Although Examiner has cited particular columns, line numbers, and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore it must be noted that the documents cited on any enclosed PTO-892 or PTO-149 form are cited in their entirety.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 12, 2009

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